

REMARKS

Claims 1-3, 7-11, 13, 23-27, 29-35, 38, 40, and 42-51 are pending in the present application.

This Amendment is in response to the Advisory Action mailed on May 28, 2009 and the Final Office Action mailed March 31, 2009. In the Final Office Action, the Examiner rejected claims 1-3, 7-11, 13, 23-27, 29-35, 38, 40, and 42-51 under 35 U.S.C. §103(a). Applicant has amended claims 1, 3, 8-11, 23, 25, 29-34, 38, 42, and 49 to, *inter alia*, eliminate potential §112 (second paragraph) informalities.

Applicant incorporates by reference the arguments set forth in the Amendment filed on May 18, 2009 and requests entry of the amendments herein. Please note that these amendments do not include the language "the remote source being different from the local source" which the Examiner contends raises new issues that warrant a further search.

Entry of these amendments and reconsideration as to the allowability of the pending claims is respectfully requested.

Claims Rejected Under 35 U.S.C. § 103

Claims 1-3, 7-11, 13, 23-27, 29-35, 38, 42, 44, and 47 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,301,586 (Yang) in view of U.S. Patent No. 6,567,983 (Shiimori), U.S. Patent Publication No. 2003/0133019 (Higurashi) and U.S. Patent No. 6,571,221 (Stewart); claims 24, 43, and 46 under 35 U.S.C. § 103(a) as being unpatentable over Yang in view of Shiimori in view of Stewart and in further view of U.S. Patent No. 6,369,835 (Lin); claims 38 and 40 under 35 U.S.C. §103(a) as being unpatentable over Yang in view of Lin in view of Higurashi and in further view of Stewart; claims 45 and 48 under 35 U.S.C. §103(a) as being unpatentable over Yang in view of Shiimori in view of Higurashi in view of Stewart and in further view of U.S. Patent No. 6,892,351 (Vasudevan); claims 49 and 50 under 35 U.S.C. §103(a) as being unpatentable over Yang in view of Lin in view of Higurashi in view of Shiimori in further view of Stewart; claim 51 under 35 U.S.C. §103(a) as being unpatentable over Yang in view of Lin in view of Higurashi in view of Shiimori in view of Stewart and in further view of Vasudevan. Applicant respectfully submits that a *prima facie* case of obviousness has not been established.

To establish a *prima facie* case of obviousness, certain basic criteria must be met. For instance, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. See MPEP §2143. Applicant respectfully submits that the combined teachings do not address each and every limitation, and thus no *prima facie* case of obviousness has been established.

Furthermore, the Supreme Court in Graham v. John Deere, 383 U.S. 1, 148 USPQ 459 (1966), stated: “Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined.” See MPEP §2141. In KSR International Co. vs. Teleflex, Inc., 127 S.Ct. 1727 (2007) (Kennedy, J.), the Court explained that “[o]ften, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to *determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.*” *Emphasis Added*. The Court further required that an explicit analysis for this reason must be made. “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” KSR, 127 S.Ct. at 1741, quoting In re Kahn, 441 F.3d 977, 988 (Fed. Cir. 2006).

In the instant case, Applicant respectfully submits that there are significant differences between the cited references and the claimed invention and there is no apparent reason to combine the known elements in the manner as claimed, and thus no *prima facie* case of obviousness has been established.

For example, Applicant respectfully submits that Yang, Shiimori, Higurashi, Lin, and Stewart, alone or in combination, fail to disclose at least “receiving compensation from the client before the visual presentation is sent to the client, an amount of compensation varies depending on which one or more sources of a plurality of sources are accessed to retrieve the plurality of presentation images, the plurality of sources including a remote source and a local source, the

remote source being different from the local source, the one or more sources including at least one of the remote source and the local source, where the remote source is more expensive to access than the local source”, as delineated in amended independent claims 1, 23, 38 and 49.

In the Office Action, the Examiner admits that Yang in view of Shiimori in view of Higurashi fails to teach or suggest “requesting and receiving compensation from the client before the visual presentation is sent to the client, an amount of compensation varies depending on which sources of the plurality of sources are accessed to retrieve the plurality of presentation image where a first remote source is more expensive to access presentation images than a local second source”, as delineated in independent claims 1, 23, 38, and 49 (Final Office Action, pages 4, 8, 15 and 19). However, Examiner alleges that Stewart teaches this element of the claims. Applicant respectfully disagrees.

Stewart merely discloses each subscriber to the network service having a “value bucket” which determines the amount of network access or service available to the user. Billing for access to the network communication service, i.e., the amount the “value bucket” is drained or filled, may be based on one or more of a number of factors, including information stored in the digital certificate, such as the geographic location of the user (Stewart, col. 3, lines 26-40). For example, the digital certificate of a user may contain information indicating the user is a member of the American Airlines Advantage program. If this user accesses the service provider's network through an access point located near an American Airlines gate or in an American Airlines Admiral's Club, American Airlines may choose to allow the user free or reduced rate access while connected to the network (Stewart, col. 3, lines 57-67).

Accordingly, in Stewart, a subscriber is merely given access to a service provider's network through an access point. In other words, the subscriber is being provided access to a network and is being billed for this access. In contrast the claims recite “receiving compensation from the client before the visual presentation is sent to the client, an amount of compensation varies depending on the one or more specified sources being accessed to retrieve the plurality of presentation images.” *Emphasis added*. Given that the subscriber in Stewart is merely accessing a network, there is no teaching or suggestion in Stewart of sending the visual presentation to the user or retrieving presentation images. Moreover, in Stewart, the subscriber is billed for the

access to the network whereas in the present invention the client provides an amount of compensation before the visual presentation is sent to the client. Accordingly, access to the Internet cannot correspond to a visual presentation, as delineated in the claims, Stewart fails to teach this element of the claims.

Additionally, the claims recite “an amount of compensation varies depending on which one or more sources of a plurality of sources are accessed to retrieve the plurality of presentation images, the plurality of sources including a remote source and a local source, the one or more sources including at least one of the remote source and the local source, where the remote source is more expensive to access than the local source.” *Emphasis Added*. Applicant respectfully submits that the geographic location of the user (e.g., distance from the American Airlines gate) is not equivalent to “a remote source” or “a local source”, as alleged by the Examiner. Since the user merely gains access to the same network whether he is geographically close or far from the American Airlines gate, this one “service provider’s network” cannot be both a remote source and a local source. Accordingly, there is no teaching in Stewart of, at least, “an amount of compensation varies depending on which one or more sources of a plurality of sources are accessed.”

In the Final Office Action, the Examiner states “Stewart teaches this limitation because it charges customers at difference based on the location of the service access point, which is similar to source of retrieve. Therefore, Stewart teaches this limitation” (Final Office Action, page 21). Applicant respectfully disagrees.

In the present invention, “the plurality of sources are accessed to retrieve the plurality of presentation images.” There is no teaching or suggestion in Stewart of retrieving presentation images from these access points. Instead, these access points provide access to the service provider’s network. Accordingly, contrary to that alleged by the Examiner, the access point are not a source from which to retrieve presentation images, but rather merely a point from which a network may be accessed. Thus, access points cannot correspond to the plurality of sources including a remote source and a local source.

In addition, amended dependent claims 9, 10, 31, and 32 recite the following limitation: “loading the plurality of presentation images from a database, the database being the remote

source.” The Examiner alleges that Yang discloses this element of the claims. Applicant respectfully disagrees and submits that Yang merely discloses a Jet database engine (DBEngine object 64) owning Workspace 65 which contains objects that define network connectivity and access (Yung, col. 7, lines 5-17). Since the database engine object 64 is merely represents data access objects, there is no teaching of loading the plurality of images from the database engine object 64, allegedly the database as recited in the claims.

Further, dependent claims 9, 10, 31, and 32 recite “the database being the remote source.” Modifying Stewart to incorporate the teachings of Yang would render the Stewart technique being modified unsatisfactory for its intended purpose, or change its principle of operation. If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). If the proposed modification or combination of the prior art would change the principle of operation of the prior invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). Here, modifying Stewart to incorporate the Yang would render the Stewart technique unworkable because the access points, allegedly a remote source, cannot be replaced by the database engine object 64. The access points in Stewart provide access to a network while the database engine object 64 in Yang merely represents data access objects. Since the database engine object 64 cannot provide access to a network to subscribers, the Stewart technique would be unworkable. Thus, there is no suggestion or motivation to make the proposed modification.

As discussed above, Yang, Shiimori, Higurashi and Stewart do not disclose or render obvious elements of independent claims 1, 23, 38, and 49. Accordingly, a combination of Yang, Shiimori, Higurashi and Stewart with any other references in rejecting claims dependent thereon is improper.

Moreover, the Examiner rejected claims 1-3, 7-11, 13, 23-27, 29-35, 38, 40, and 42-51 under 35 U.S.C. §103(a) as being unpatentable over a combination of Yang, Shiimori, Higurashi, Stewart, Lin, and Vasudevan. Applicant respectfully submit that a *prima facie* case of obviousness has been established because neither Yang, Shiimori, Higurashi, Stewart, Lin, nor

Vasudevan, alone or in any combination, describe each and every claimed element or suggest such combination. However, based on the allowability of independent claims 1, 23, 38, and 49 upon which claims 2-3, 7-11, 13, 24-27, 29-35, 40, 42-48, and 50-51 depend, Applicant believes that claims 2-3, 7-11, 13, 24-27, 29-35, 40, 42-48, and 50-51 also are in condition for allowance. No further discussion of the grounds for traversing these rejections is warranted. However, Applicant reserves the right to present such grounds for traverse if an appeal is warranted.

Accordingly, Applicant respectfully submits that a *prima facie* case of obviousness has not been established, and thus, withdrawal of the §103(a) rejection as applied to claims 1, 23, 38, and 49 are respectfully requested.

Conclusion

In view of the foregoing, it is believed that all claims now pending patentably define the subject invention over the prior art of record, and are in condition for allowance and such action is earnestly solicited at the earliest possible date. Entry of these amendments is solicited because these amendments clarify the claims and do not include the content that the Examiner considers to raise new issues. If the Examiner believes that a telephone conference would be useful in moving the application forward to allowance, the Examiner is encouraged to contact the undersigned at (714) 557-3800.

Respectfully submitted,

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